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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,278	08/31/2000	Akinari Takagi	2369.12203	4771

5514 7590 01/25/2005

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NEW YORK, NY 10112

EXAMINER
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SPECTOR, DAVID N

ART UNIT	PAPER NUMBER
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2873

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/653,278

Applicant(s)

TAKAGI ET AL.

Examiner

David N. Spector

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08/31/2000, 05/29/2001, and 01/21/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☒ Claim(s) 14-42 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20010529, 20040121.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: DETAILED ACTION.

**DETAILED ACTION*****Objections to the Claims***

The following claims are objected to under 37 CFR 1.75 as being substantial duplicates. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim 1/2 is a substantial duplicate of Claim 14;

Claim 1/2/3 is a substantial duplicate of Claim 14/16;

Claim 1/2/4 is a substantial duplicate of Claim 14/17;

Claim 1/2/5 is a substantial duplicate of Claim 14/18;

Claim 1/2/6 is a substantial duplicate of Claim 14/19;

Claim 1/2/8 is a substantial duplicate of Claim 14/20;

Claim 1/2/3/9 is a substantial duplicate of Claim 14/16/20;

Claim 1/2/4/10 is a substantial duplicate of Claim 14/17/22

Claim 1/2/5/11 is a substantial duplicate of Claim 14/18/23;

Claim 1/2/6/12 is a substantial duplicate of Claim 14/19/24.

Claims 1, 2, and 14 are further objected to for the use of the somewhat archaic term "ocular optical system" (Claim 1, Lines 10-11 and 18; Claim 2, Line 7; Claim 14, Lines 9-10 and 21) therein to refer to the optical system of an observer's eye. In contemporary practice, however, the term ocular optical system is generally used to denote the eyepiece of an optical system. This is particularly confusing as used in claims 1, 2, and 14 (e.g. which also expressly recite the term "eyepiece optical system" therein). Since the examiner understands the intended meaning of "ocular optical system", the aforesaid lack of clarity is being addressed herein under an objection to the affected claims rather than rejections thereto under 35 USC 112, second paragraph. Correction is required

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Claims 1, 3, 14, 16, 25, 34, and 35 are further objected to for the use of the ambiguous term "outside image" (Claim 1, Lines 2-3; Claim 3, Line 3; Claim 14, Lines 2 and 4; Claim 16, Line 3; Claim 25, Lines 5 and 8; Claim 34, Line 4; Claim 35, Lines 5 and 8). Since the examiner understands the intended meaning of "ocular optical system", the aforesaid lack of clarity is being addressed herein under an objection to the affected claims rather than rejections thereto under 35 USC 112, second paragraph. Correction is required.

Claims 1, 14, 25, and 36 are further objected to for the use of the ambiguous term "outside optical axis" (Claim 1, Line 12; Claim 14, Lines 14-15; Claim 25, Line 11; Claim 36, Line 2). Since the examiner understands the intended meaning of "outside optical axis", the aforesaid lack of clarity is being addressed herein under an objection to the affected claims rather than rejections thereto under 35 USC 112, second paragraph. Correction is required.

Claims 1, 14, and 41 are further objected to for the use of the ambiguous term "shifted toward the outside" (Claim 1, Lines 15-16; Claim 14, Lines 14-15; Claim 41, Line 5). Since the examiner understands the intended meaning of "shifted toward the outside", the aforesaid lack of clarity is being addressed herein under an objection to the affected claims rather than rejections thereto under 35 USC 112, second paragraph. Correction is required.

### ***Objections to the Drawings***

Figures 10, 23 and 28 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claim 1 is rejected (e.g. along with claims 1/3, 1/4, 1/5, 1/6, 1/7, 1/8, 1/3/9, 1/4/10, 1/5/11, 1/6/12, and 1/7/13 which depend there from) under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: a characterization of the amount of shift of the entrance pupil of the image pickup optical system toward the object side thereof, relative to the position equivalent to the entrance pupil of the observer's eye.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hadani (U.S. Patent No. 4,467,190). In particular, Hadani discloses an image observation apparatus comprising an image pickup system for acquiring an outside image via an image pickup optical system, and a display system for displaying the outside image acquired by the image pickup system on display means and guiding light from the display means via an eyepiece optical system to an eye, in which a position of an exit pupil of the eyepiece optical system is approximately matched with a position of an entrance pupil of an ocular optical systems so as to permit observation of the image, wherein an outside optical axis of the image pickup optical system is approximately aligned with an extension line of an eye-side optical axis of the eyepiece optical system and wherein an entrance pupil of the image pickup optical system is shifted toward the outside from a position equivalent to the entrance pupil of the ocular optical system. Claim 1 is therefore clearly anticipated by Hadani.

### ***Provisional Double Patenting Rejection***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

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harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).


Claims 25-41 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 10/722,444 (US 2004/0140949 A1). This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Other Remarks/Information***

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any other inquiry concerning this communication or earlier communications from the examiner should be directed to David N. Spector whose telephone number is (571) 272-2338. The examiner can normally be reached at this number Monday through Friday between 6:00 AM and 2:30 PM. The fax number for the organization where this application is assigned is (703) 872-9306.

January 19, 2005



DAVID N. SPECTOR  
PRIMARY EXAMINER